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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,679	07/11/2000	Gerard J. Barry	2270-010	1238
7590	11/16/2005		EXAMINER	
Lowell W Gresham Meschkow & Gresham PLC Suite 409 5727 North Seventh Street Phoenix, AZ 85014			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 11/16/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/613,679	BARRY, GERARD J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ella Colbert	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 June 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-8, 10, 12-23 and 25-40 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,3-8, 10, 12-23, and 25-40 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. Claims 1, 3-8, 10, 12-23, and 25-40 are pending. Claims 1, 10, 23, and 37 have been amended in this communication filed 06/20/05 entered as Amendment with filing of RCE.
2. The Petition for Extension of Time (One Month) filed 06/20/05 will be entered.
3. The 35 USC 101 rejection of claims 1, 3-8, 31, 32, and 37-40 has been overcome by Applicants' amendment to claims 1 and 37 and is hereby withdrawn.

### ***Continued Examination Under 37 CFR 1.114***

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/20/05 has been entered.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1, 3, 10, 12, 23, 25, and 37 recites the limitation "Identifier code", "issuer code", and "issuer codes". Also it is unclear whether there is an "identifier code" and "issuer code" or "issuer codes". Are there two separate codes? There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Objections***

7. Claims 4 and 26 are objected to because of the following informalities: Claim 4, line 2 recites "wherein the card holder ...". This line would be better recited as "wherein the cardholder ...". "Card holder" is inconsistent with the other claim limitations because throughout the other claims "cardholder" is recited. Claim 26 has a similar problem. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 3, 10, 12, 23, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by (US 5,870,473) Boesch et al, hereafter Boesch.

With respect to claims 1, 10, and 23, Boesch teaches, A data processing method performed in a data processing system for determining a preferred currency for association with a payment card transaction between a merchant and a payment card cardholder, said method including the steps of; obtaining the card number of the payment card (col. 11, lines 26-65, fig. 4K, and fig. 5H); in said data processing system, identifying an identifier code from said card number (col. 12, lines 16-18 ("BIN" – identifier code)), determining the operating currency for said identifier code by comparing said identifier code with entries in a table wherein each entry in said table

contains an issuer code or range of issuer codes and a corresponding currency code (col. 12, line 50-col. 13, line 10), and setting the currency for association with the payment card transaction as the determined operating currency for the identifier code (col. 14, lines 17-30).

With respect to claim 10, Boesch further teaches, means for obtaining the card number of the payment card from the cardholder (col. 16, lines 43-67 and col. 17, lines 40-44).

With respect to claim 23, Boesch teaches, A computer program encoding a set of computer instructions for use in a computing device (col. 30, lines 13-21). However, it would have been inherent to the computer system to have a computer program encoding a set of computer instructions for use in a computing device since a computer program is a set of instruction for telling a computer what to do and the encoding is merely a means of producing a unique combination of bits (a code) in response to an analog input signal.

With respect to claims 3, 12, and 25, Boesch teaches, A method according to claim 1, wherein the preferred currency is set to default currency of the merchant when no operating currency can be determined for the issuer code (col. 13, lines 3-33).

10. Claims 4-8, 13 -16, and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,870,473) Boesch et al, hereafter Boesch in view of (EP 0251619) Boston.

Art Unit: 3624

With respect to claims 4, 13, and 26, Boesch failed to teach, wherein the cardholder is prompted as to whether the transaction is to be conducted in the preferred currency, including the steps of converting the transaction amounts to equivalent amounts in the preferred currency and presenting these amounts for review by the cardholder. Boston teaches, wherein the cardholder is prompted as to whether the transaction is to be conducted in the preferred currency, including the steps of converting the transaction amounts to equivalent amounts in the preferred currency and presenting these amounts for review by the cardholder (page 5, paragraphs 3 & 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein the cardholder is prompted as to whether the transaction is to be conducted in the preferred currency, including the steps of converting the transaction amounts to equivalent amounts in the preferred currency and presenting these amounts for review by the cardholder and to modify in Boesch because such a modification would allow Boesch to have the transaction amount expressed in the foreign currency using the associated conversion rate.

With respect to claims 5 and 27, Boesch failed to teach, wherein at least one of the transaction amounts is converted to an equivalent amount in the preferred currency and is presented to the cardholder. Boston teaches, wherein at least one of the transaction amounts is converted to an equivalent amount in the preferred currency and is presented to the cardholder (page 5, paragraph 4 and page 6, paragraphs 1 and 2 (display screen)). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein at least one of the transaction

Art Unit: 3624

amounts is converted to an equivalent amount in the preferred currency and is presented to the cardholder and to modify in Boesch because such a modification would allow Boesch to have the transaction amount expressed in a foreign currency and entered through the data entry means and compared to the converted transaction limit to determine if the transaction should be approved. Page 6, paragraphs 1 and 2 teach a display.

With respect to claims 6, 15, and 28, Boesch failed to teach, further comprising the step of presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency. Boston teaches, further comprising the step of presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency (page 5, paragraph 4 and page 11, paragraphs 2 and 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the step of presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchants' currency and the preferred currency and to modify in Boesch because such a modification would allow Boesch to have the issuer to be supplied with the cardholder's name, account number, and the countries to which the cardholder will be traveling and then the issuer will generate a conversion rate.

With respect to claims 7 and 29, Boesch failed to teach, wherein the transaction details in the merchants currency are also presented to the cardholder. Boston teaches, wherein the transaction details in the merchant's currency are also presented

to the cardholder (page 11, paragraph 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the transaction details in the merchants currency are also presented to the cardholder and to modify in Boesch because such a modification would allow Boesch to have a favorable rate which is unlikely to be reached in a given time period.

With respect to claims 8, 16, and 30, Boesch failed to teach, further comprising the step of initially checking to determine if the transaction amount exceeds a predetermined minimum level for processing in an alternative currency to that of the merchants currency. Boston teaches, further comprising the step of initially checking to determine if the transaction amount exceeds a predetermined minimum level for processing in an alternative currency to that of the merchants currency (page 11, paragraphs 3 and 4 and page 12, paragraphs 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the step of initially checking to determine if the transaction amount exceeds a predetermined minimum level for processing in an alternative currency to that of the merchants currency and to modify in Boesch because such a modification would allow Boesch to have a conversion rate that does not have to be exact since it is not being used to reconcile a transaction and the rate is not used as the basis to transfer funds from the cardholder to the merchant.

With respect to claim 14, Boesch teaches, further comprising means for accepting an indication from the cardholder as to whether the transaction is to proceed

in the preferred currency and means for permitting the transaction to be processed in the preferred currency if such an indication is received (col. 13, lines 3-13).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 17-22 and 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,870,473) Boesch et al, hereafter Boesch and (EP 0251619) Boston in view of (WO 95/12169) Levine et al, hereafter Levine.

With respect to claim 17, Boesch and Boston failed to teach, wherein said data processing system is embodied in a payment card terminal. Levine teaches, wherein said data processing system is embodied in a payment card terminal (page 9, lines 24-37, page 10, lines 30-37, and page 11, lines 1-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a data processing system embodied in a payment card terminal and to modify in Boesch because such a modification would allow Boesch to have the capability to look up the entries corresponding to the issuer code and to locate a particular account number.

With respect to claim 18, Boesch and Boston failed to teach, wherein said data processing system is embodied in a central payment router. Levine teaches, wherein

said data processing system is embodied in a central payment router (Fig. 3, element 43, element 50, and element 51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the data processing system embodied in a central payment router and to modify in Boesch because such a modification would allow Boesch to have the ATM connected to the network via a communications link and to transmit the data relating to the currency and the currency amount.

With respect to claim 19, Boesch and Boston failed to teach, wherein said data processing system is embodied in an authorisation host, optionally in co-operation with another system. Lavine teaches, wherein said data processing system is embodied in an authorisation host, optionally in co-operation with another system (page 8, lines 16-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a data processing system embodied in an authorisation host, optionally in co-operation with another system and to modify in Boesch because such a modification would allow Boesch to have a terminal that allows for servicing and control and an ATM that acts as an interchange to a card network.

With respect to claim 20, Boesch and Boston failed to teach, wherein said other system is a payment card terminal or central payment router. Levine teaches, wherein said other system is a payment card terminal or central payment router (Fig. 3 (central payment router link 43, network 51, and ATM 50)). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the other system as a payment card terminal or central payment router and to modify in

Boesch because such a modification would allow Boesch to the ATM connected to the network via a communications link and to transmit the data relating to the currency and the currency amount.

With respect to claim 21, Boesch and Boston failed to teach, further comprising means for connecting to a node in a computer network. Lavine teaches, further comprising means for connecting to a node in a computer network (page 8, lines 16-19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have means for connecting to a node in a computer network and to modify in Boesch because such a modification would allow Boesch to have the processor connected to a network such as Visanet network.

With respect to claim 22, Boesch and Boston failed to teach, wherein the card number is received via the computer network. Lavine teaches, wherein the card number is received via the computer network (page 4, lines 11-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the card number received via the computer network and to modify in Boesch because such a modification would allow Boesch to have the terminal that a customer uses connected to an intermediate network such as the VisaNet network.

With respect to claim 31, Boesch and Boston failed to teach, wherein the card holder is prompted as to whether the transaction is to be conducted in the preferred currency, including the steps of converting the transaction amounts to equivalent amounts in the preferred currency and presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchant's currency and the

preferred currency. Lavine teaches, A method according to claim 1, wherein the card holder is prompted as to whether the transaction is to be conducted in the preferred currency, including the steps of converting the transaction amounts to equivalent amounts in the preferred currency and presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchant's currency and the preferred currency (page 11, line 3- page 12, line 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the card holder prompted as to whether the transaction is to be conducted in the preferred currency, including the steps of converting the transaction amounts to equivalent amounts in the preferred currency and presenting an exchange rate to the cardholder, said exchange rate corresponding to a rate between the merchant's currency and the preferred currency and to modify in Boesch because such a modification would allow Boesch to have any required currency translation performed by the network and to have an ATM that transmits a currency code that shows what the currency is in the ATM.

With respect to claim 32, this dependent claim is rejected for the similar rationale as above for claim 31.

With respect to claim 33, this dependent claim is rejected for the similar rationale as given above for claims 31 and 32.

With respect to claim 34, this dependent claim is rejected for the similar rationale as given above for claims 31-33.

With respect to claim 35, this dependent claim is rejected for the similar rationale as given above for claims 31-34.

With respect to claim 36, this dependent claim is rejected for the similar rationale as given above for claims 34 and 35.

With respect to claim 37, Boesch teaches, A method of operating a data processing system to conduct a financial transaction for the exchange of money provided by a payment card cardholder for a good or service provided by a merchant, said method comprising: obtaining a card number from said payment card (col. 11, lines 26-65, fig. 4K, and fig. 5H); identifying, in said data processing system, an identifier code from said card number (col. 12, lines 16-18 ("BIN" –id code)); and determining an operating currency for said identifier code by comparing said identifier code with entries in a table that associates issuer codes with currency codes and indicating said operating currency as being a preferred currency of exchange for said financial transaction (col. 12, line 50-col. 13, line 10). Boesch failed to teach, receiving a cardholder reply in response to said indicating activity; and completing said financial transaction in response to said receiving activity. Boston teaches, receiving a cardholder reply in response to said indicating activity (page 15, paragraph 2 – page 16, paragraph 2); and completing said financial transaction in response to said receiving activity (page 12, paragraphs 2- 4 and Page 16, paragraph 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to receive a cardholder reply in response to said indicating activity; and complete said financial transaction in response to said receiving activity and to modify in Boesch because such a modification would allow Boesch's system to compare the transaction

amount that has been entered with the amount of the transaction expressed in the foreign currency.

With respect to claim 38, Boesch failed to teach, A method as claimed in claim 37 wherein: said cardholder reply instructs said data processing system to conduct said financial transaction using said preferred currency; and said completing activity completes said financial transaction using said preferred currency. Boston teaches, A method as claimed in claim 37 wherein: said cardholder reply instructs said data processing system to conduct said financial transaction using said preferred currency (page 12, paragraph 3 –page 15, paragraph 1); and said completing activity completes said financial transaction using said preferred currency (page 15, paragraph 2 –page 16, paragraph 3). It would it have been obvious to one having ordinary skill in the art at the time the invention was made to have the cardholder reply instructs said data processing system to conduct said financial transaction using said preferred currency; and said completing activity completes said financial transaction using said preferred currency and to modify in Boesch because such a modification would allow Boesch's system to have an approval given and an authorization code to be generated for the transaction amount.

With respect to claim 39, Boesch failed to teach, A method as claimed in claim 38 wherein: said indicating activity additionally indicates a currency exchange rate for converting from a merchant currency to said preferred currency; and said completing activity uses said currency exchange rate in completing said financial transaction. Boston teaches, the indicating activity additionally indicates a currency exchange rate

for converting from a merchant currency to said preferred currency (page 14, paragraph 2- page 15, paragraph 3); and said completing activity uses said currency exchange rate in completing said financial transaction Page 15, paragraph 4- page16, paragraph 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the indicating activity additionally indicates a currency exchange rate for converting from a merchant currency to said preferred currency; and said completing activity uses said currency exchange rate in completing said financial transaction and to modify in Boesch because such a modification in Lavine's system would allow Boesch to allow the cardholder to enter an amount of the transaction in the currency selected and to convert from a merchant currency to the customer's preferred currency.

With respect to claim 40, Boesch failed to teach, A method as claimed in claim 38 wherein said indicating activity additionally indicates a first amount of money for said financial transaction using a merchant currency and a second amount of money for said financial transaction using said preferred currency. Boston teaches, wherein said indicating activity additionally indicates a first amount of money for said financial transaction using a merchant currency and a second amount of money for said financial transaction using said preferred currency (page 10, paragraph 3- page 11, paragraph 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the indicating activity additionally indicates a first amount of money for said financial transaction using a merchant currency and a second amount of money for said financial transaction using said preferred currency and to modify in

Boesch because such a modification would allow Boesch's system to have the transaction converted from the base currency in one amount and converted to the selected foreign currency in that foreign currencies amount.

### **Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cerra (US 6,546,373) disclosed cash in a local currency or in a currency of the country in which the traveler resides and a debit card for making purchases from a merchant.

Carol Power, "IRT Business & Finance (Wired on Friday): Big Apple not ready to abandon cash, trial finds" disclosed DigiCash, CyberCash, and ecash.

Panurach, Patiwat, "Money in electronic commerce: Digital cash, electronic fund transfer, and ecash" disclosed electronic payments, digital cash, prepaid cards, and world currency access accounts.

Energy Services & Telecom Report (formerly DSR), "Utilities Use Internet For Bills, Vendor Payments, Power Marketing" disclosed Cybercash and cash transactions from bank accounts.

### **Inquiries**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

Art Unit: 3624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert  
Primary Examiner  
November 12, 2005